

Application No. 10/802,640
Amendment dated January 7, 2008
Reply to Office action of October 5, 2007

REMARKS/ARGUMENTS

Claim 16 was objected to as to form. Claim 16 as presently amended, is believed to correct the formal deficiency noted by the Examiner. If the Examiner has any other questions with respect to claim form or content, Applicant's undersigned attorney would be happy to discuss the matter at 314.238.2400.

Claims 16, 20, 21, 5 and 7 were rejected under 35 U.S.C. 102 (b) as being anticipated by Bechtel et al, U.S. patent 5, 371,991 ('991). Claims 2-3, 17, 19, 8 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bechtel in view of Schumacher et el, U.S. Patent 4,121,798. The claims as amended and presented are believed to distinguish structurally from the art of record and to be unobvious over the art, whether the art is considered singly or in combination.

Applicant has devised an extremely successful device used to quickly and efficiently set up and/or remove, in conjunction with what are commonly known as retail displays or display towers, attention attracting items in the form of small signs or panels often used by department stores and similar merchants to attract the attention of their customers to a particular display of goods. In one form, the invention comprises an elongated clip with a unitary body having an intermediate section and a first pair of opposed arms, the body having an interior surface and an exterior surface arranged to define an elongated open mouth axially extending channel and a second pair of opposed arms formed along the external surface proximate one of the arms of the first

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pair of opposed arms. Each of these opposed arm pairs are constructed and arranged to accept the different dimensions of display itself and the small signs or panels used in conjunction with the displays. The claims have been amended to more specifically require that the channel mounts to the display while the second pair of opposed arms receive at least a portion of the display panel.

None of the art of record discloses similar structure or gives a similar result. Bechtel '991, relied upon by the Examiner in the context of the original claims, discloses a re-bar clamp for use in forming concrete footings that require the reinforcing steel rods to be spaced upwardly at a predetermined height above ground so that when the concrete is poured into the footings, the reinforcing bars will be completely encapsulated by the concrete. Bechtel nowhere describes even vaguely intimates a use or a construction which will accomplish Applicant's result. Nor does Bechtel show a construction in which different configurations of arms define the channel which receives different dimensions of the respective two parts with which applicant's invention finds application. Since 102 requires that a single reference meet all of the structural limitations of the claims, the rejections under 102 of the Patent Statute are respectfully traversed.

The M.P.E.P. provides at §2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention

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must be shown in as complete detail as contained in ... claim." *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Because there is no suggestion in the '991 patent to provide a clip having a first set of opposed arms which in part define an axially extending channel for receiving at least a portion of a merchandise display, either along or in conjunction with a second pair of opposed arms located proximate to one of the arms of the first part, the second pair of opposed arms receiving a portion of a display panel wherein each of the different configuration of arms receive different dimensions of the respective tow parts with which applicant's invention finds application as required by the claims, reconsideration and withdrawal of the rejection under 35 USC 102 are respectfully requested.

It is respectfully suggested that the claim rejections based on 35 U.S.C. 103 are also without merit. It is only with the hindsight knowledge proved by applicant's disclosure that one skilled in the art would consider the combination of references being made by the Examiner for any purpose related to Applicant's invention, and even with that hindsight, the '991 structure will not function, alone or in combination with the art of record, for any purpose related to Applicant's invention without substantial modification. But that modification is only provided by Applicant's disclosure, and not the art of record. Schumacher, 4,121,798 was relied upon by the Examiner, again in the context of the original claims, to show an outward flare at the ends of each of the pair of arms. However, all of the claims, as amended and presented, require more. For example, as

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indicated above the claims all require an elongated open mouth channel defined by an intermediate section and a first pair of opposed arms for receiving at least a portion of a merchandise display, and a second pair of opposed arms located proximate of one of the arms of the first pair of opposed arms for receiving at least a portion of a display panel, the clip being arranged to receive, hold and operate with parts having different dimensions. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure." MPEP § 2143. Further, "a statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP §2143.01(IV) (emphasis in original).

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

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teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." MPEP §2143.01(l) (Citations omitted)

The recent KSR case (*KSR Int'l. Co. v. Teleflex, Inc.* No 04-1350 (U.S. Apr. 30, 2007) is not believed to have altered these requirements. In the instant case, a person of ordinary skill in the art having common sense at the time of the invention would not have reasonably looked to Schumacher et al to solve a problem allegedly solved by Bechtel. Even if that person of ordinary skill would make the leap of faith being made by the Examiner, the combination of Bechtel and Schumacher does not provide the structure now required by the claims or give Applicant's result. An artisan having common sense at the time of the invention would not have reasonably considered using a device intended to be embedded in concrete for any purpose, and certainly not in the manner suggested by the Examiner.

Entrance of this amendment places the case in condition for allowance or in better form for appeal. The amendment was not presented earlier because of Applicant's belief that the claims previously distinguished over the art. No further search is required on the part of the Office in that the structure of the claims have been present in the case since its inception.

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For the reasons that the claims as amended and presented are believed to distinguish structurally from the art of record, whether that art is considered singly or in combination, entrance of the amendment, reexamination of claims, and passage of the case to issue are respectfully requested.

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